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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,852	03/05/2007	Hiroshi Uemura	K6510.0082/P082	1640

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EXAMINER	
JONES, MARCUS D	

ART UNIT	PAPER NUMBER
3717	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/585,852	UEMURA ET AL.	
	Examiner	Art Unit	
	Marcus D. Jones	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *6-8* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 9-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) *6-8* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/12/06, 7/2/07, 3/4/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-5 and 9-11, drawn to card game system, classified in class 463, subclass 29.

   II. Claims 6-8 drawn to game system with a virtual camera, classified in class 463, subclass 31.

2. Inventions I and II are directed to related products. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed do not overlap in scope. Invention I requires the use of a bar code reader and Invention II requires the use of a camera. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention**.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Jonathan Falkner on 27 September 2010 a provisional election was made without traverse to prosecute the invention of claims 1-5 and 9-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter wherein the claim recites software *per se*. A program for a game system and a game program is a data structure merely comprising a set of instructions. Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g. *Warmerdam,* 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held non-statutory). Such claimed data structures do not define any structural and functional relationships between the data structure and other claimed aspects of the invention that permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and thus are statutory. Appropriate attention is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Murata (US 5,586,238).

In reference to claims 1, 5, and 9, Murata discloses: A game system comprising: a code reading means for reading in a code recorded in a card (bar code reader 28); a character generating means for generating a character, based on a combination of a plurality of codes read in by the reading means; and a character evaluating means for evaluating the generated character (col 1, ln 52-57, *object image creating means for reading, for each of the parts of the object from the storage means, a data item on a part image corresponding to the related data item read by the read means on the basis of the read related data item, and combining the read data items on the respective part images to create an object image.*), the game system further comprising a memory means for storing at least base character data which are a base for the generated character, first part data for forming a part of the character, which corresponds to a first code, and a plurality of second part data for forming other parts of the character, which corresponds to a second code (RAM 26 and ROM 24 and see Figures 3 and 4, and col 4, ln 14-19), the character generating means including: a base character image generating means for reading out the base character data and generating a base character image (col 6, ln 8-11, *the portrait data indicative of the first basic portrait image is for the famous person "A" portrait, data on which is stored in the storage area 32a of the basic form ROM 32*); a first part changing means which, when the first code is read in, reads out the first part data corresponding to the first code from the memory means and changes a part of the base character data by the readout first part data; a

second part changing means which, when the second code reads out, out of said plurality of second part data, one second part data corresponding to the second code and changes another part of the base character image by the second part data; a third part changing means which, when the second code is read again, selects and reads out one second part data out of said plurality of second part data other than the second part data selected by the second part changing means, and changes another part of the base character image by the selected second part data (col 4, ln 63-67, *The RAM 26 further includes a data synthesis RAM 33, which temporarily stores data on the respective part patterns read from the part pattern ROM 31 in correspondence to the portrait image data stored in the RAM 26 for synthesis of the respective part patterns. The portrait image including the part patterns synthesized in the data synthesis RAM 33 is stored in the display area 26c and displayed on the display 3. and col 6, ln 26-39, This data synthesis process is performed in accordance with a flowchart of FIG. 9. First, that of the part pattern numbers which involve the portrait data stored in the portrait data area 26b of the RAM 26 and which involves the "hair style" having a smallest part number is read (step S901). Data on the part pattern indicated by the read part pattern number is read from the part pattern ROM 31 and stored in the data synthesis RAM 33 (step S902). A part pattern number which involves the "front hair style" having the next smallest part number is then read (step S903). Part pattern data corresponding to the read part pattern number is read from the part pattern ROM 31 and then stored in the data synthesis RAM 33 (step S904).*); and a character image generating means for generating a character image, based on the character data changed by at least any one

of the first part changing means, the second part changing means and the third part changing means (col 1, ln 52-57, *object image creating means for reading, for each of the parts of the object from the storage means, a data item on a part image corresponding to the related data item read by the read means on the basis of the read related data item, and combining the read data items on the respective part images to create an object image.*).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2, 3, 4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara (US 5.212.368), and further in view of Deoderlein et al. (US 5,480,156).

In reference to claims 2, 3, 4, 10 and 11, Hara discloses: A game system comprising: an operating means operated by a game player (see Figure 1, keys 6a, 6b); a display means for displaying a game image (LCD screen 4); a sound outputting means for outputting game sounds (sound unit 10); an evaluation means for evaluating an operation input into the operation means (col 7, ln 5-9, *calculation unit 7, Returning to step 328, if an operation of the appropriate one of the keys 6a or 6a' is not detected by the calculation unit 7, control moves to step 337 in which the calculation unit 7 determines whether an operation of an appropriate one of the keys 6b or 6b' occurred*), a control means for controlling the game (calculation unit 7, see Figure 3), a first means for displaying an image indicating an operation of the operation means on the game image by the display means (LCD screen 4); a second means for outputting a game sound indicating the operation of the operation means by the sound outputting means concurrently with the display of the image (sound unit 10), the evaluation means evaluating the operation input into the operation means, based on a timing of the operation input into the operation means and a timing of generating the game sound by the second means (col 7, ln 41-50, *waiting period*). Hara does not specifically disclose a third means for outputting an auxiliary sound. Deoderlein teaches a Voice chip 30 generates a preselected output signal which recreates the sports player's voice or other recognizable voice or sound recording related to the person or event being featured on card 10 (col 5, ln 39-41).

It would have been obvious to a person having ordinary skill in the art at the time of the invention to have modified Hara in view of Deoderlein in order to include individual character voices in the game system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus D. Jones whose telephone number is (571)270-3773. The examiner can normally be reached on M-F 9-5 EST, Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marcus D. Jones/
Examiner, Art Unit 3714

/Melba Bumgarner/
Supervisory Patent Examiner, Art Unit 3714